

REMARKS

The Official Action of April 19, 2006, and the prior art relied upon therein have been carefully reviewed. The claims in the application are now claims 25-41, and these claims define patentable subject matter warranting their allowance. Accordingly, the applicant respectfully requests favorable reconsideration and allowance.

New method claims 33-41 are presented for consideration and examination. These claims define the same invention in method terminology, and are patentable for the same reasons as the other claims, as pointed out in detail below.

Claim 25 has been rejected as obvious under §103 from newly cited Rice USP 5,845,994 (Rice) in view of Koven USP 2,258,413 (Koven), previously cited but not applied. The rejection is respectfully traversed.

Rice superficially appears to disclose similar subject matter to what is claimed, but is fundamentally different in that it does not relate to jewelry and has a number of significant structural differences. Thus, the Rice device is essentially a mesh carrying bag intended primarily for use when engaging in sports, with a closed bottom and a sturdy draw-string 26 at the upper end for closure after insertion of valuables or the like.

Applicant respectfully submits that it would have been inconceivable for the person of ordinary skill in the art, at the time the present invention was made, to have replaced the sturdy draw-string 26, regardless of the material from which it might be made, with a relatively fragile jewelry

necklace. As shown in Fig. 1 of Rice, the device of Rice is intended for use in water sports, such as surfing or swimming (column 2, line 60; column 3, line 13). Rice thus teaches the importance of strength in environments where jewelry might fail. Indeed, Rice contains not the remotest hint of jewelry, to which the present invention is directed.

Basically the same point applies to the nature of the material from which applicant's jewel pouch is formed, same being a jewelry quality metal mesh (support is found at page 6, line 9). Rice does not show or suggest formation of the Rice mesh bag from jewelry quality metal, and applicant respectfully submits that the substitution of jewelry quality metal mesh for the mesh bag materials of Rice would have been inconsistent with the intended function of sturdy use of the Rice mesh bag.

The rejection acknowledges that Rice does not disclose jewels to be placed within the mesh bag of Rice, and in this regard the PTO relies on Koven which relates to a gem setting as a pendant, the pendant incorporating a rigid frame holding a plurality of jewels. Applicant respectfully maintains that the proposed combination would not have been obvious because the objectives of Rice and Koven are so different from one another. The Koven pendants are indeed jewelry items, whereas the Rice mesh bag is not at all a jewelry item and is intended instead for safely holding valuables such as cash or change, keys, credit cards, medications, toiletries, etc. safely, "even while swimming", permitting water to flow through the openings of the mesh bag.

Applicant respectfully notes for the record that "jewelry" has a meaning, e.g. "pieces of precious metals, crystal, etc., shaped and worn for adornment." (Webster's International Dictionary, Second Edition, Unabridged, 1944).

It should be accepted that the mesh holding bag of Rice is not "jewelry".

Rice has nothing to do with jewelry. Respectfully, the proposed combination only appears to have been obvious after looking at applicant's specification, which of course was not available to the person of ordinary skill in the art at the time the present invention was made.

Claim 25 moreover is directed to a kit, and kit claims are accepted in the United States. A quick search by undersigned in the "USPTO Patent Full-Text and Image Database" on September 18, 2006, containing data current through September 12, 2006, for U.S. patents having claims including the word "kit", revealed 17,415 U.S. patents which contained claims including the word "kit". Attached is a page from such database listing the 50 most recent hits.

Applicant's kit as called for in claim 25 comprises four (4) elements, namely the jewelry necklace, the jewel pouch formed of jewelry quality metal mesh, and two (2) separate jewels. Each jewel is intended for use separately; "when one of said jewels is placed in the mesh, the mesh suspends from the necklace and the weight of the one jewel causes the necklace to at least partially close the top opening of the mesh thereby securing the jewel therein." This feature is not shown by Rice or by Koven or by any possible combination of Rice and Koven, even if such a combination were obvious, contrary to applicant's position.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 26 and 29-31 have been rejected as obvious under §103 from Rice in view of Koven, and further in view of

the ancient Tully and Irons patents, respectively 672,499 and 726,166. This rejection is respectfully traversed.

First, many of applicant's remarks above made in reply to the rejection of claim 25 apply equally as regards the proposed combination of Rice in view of Koven as applied against claims 26 and 29-31, and so such remarks are respectfully repeated by reference.

Irons relates to a purse or the like. Again, like Rice, Irons does not relate to jewelry. Tully is even more remote, relating to a laundry bag. Respectfully, why would the person of ordinary skill in the art seek to take bits and pieces from Tully, Irons and Koven, and insert those bits and pieces into the Rice mesh bag, in order to produce something entirely different, namely jewelry, and without the prior art providing any incentive or motivation to do so? Again, applicant respectfully maintains that without applicant's specification as guidance, the person of ordinary skill in the art would never have come up with the proposed combination.

In this regard, applicant respectfully wishes to particularly note the claimed ring at the bottom of applicant's jewel pouch. For this, the PTO has relied upon Tully which relates to a laundry bag. There is no reason in the world why the skilled artisan would go to a laundry bag in order to modify the Rice mesh bag for jewelry purposes. The rejection states that the Tully bottom functions equally as well as Rice's knotted bottom, but that observation is submitted (with respect) to be irrelevant. Applicant's jewelry pouch must not only function to hold the jewel, but must also function as jewelry, i.e. for adornment as called for in claim 26. The person of ordinary skill in the art would not go to Tully's laundry bag to learn about jewelry for adornment.

Withdrawal of the rejection is in order and is respectfully requested.

The rejection states with respect to claim 31, that Rice discloses strands (24) extending below the bottom knot. Applicant believes that the rejection in this regard may have been intended to apply to claim 32 rather than claim 31, although there is no specific mention of any rejection of claim 32.¹

If such rejection was intended for claim 32, applicant respectfully points out that Rice does not disclose chain strands which extend below the bottom ring as a fringe, for at least two reasons. First, there is no bottom ring in Rice. Second, the tassel 24 extending below the mesh bag of Rice is not formed of any chain strands. No possible combination of the references, even if such combination were obvious (contrary to applicant's position), could reach the subject matter of claim 32.

Claim 27 has been rejected as obvious under §103 from Rice in view of Koven, Tully and Irons, and further in view of Corridon USP 3,483,907 (Corridon). This rejection is respectfully traversed.

¹ In the absence of clarification regarding the status of claim 32, and especially an express rejection of claim 32, applicant must assume that claim 32 has not been rejected.

Claim 27 depends from and incorporates the subject matter of claim 26. Corridon has not been cited to make up for the deficiencies of the proposed combination of Rice in view of Koven, Tully and Irons as discussed above in relation to claim 26, and indeed does not do so. Therefore, even if the proposed combination of Rice and Corridon were obvious, contrary to applicant's position, the proposed combination would not reach the subject matter of claim 27 for the reasons pointed out above with respect to claim 26.

The rejection employs a combination of five (5) separate references and relies on the person of ordinary skill in the art not only having been charged with knowledge of all five references, but also having obviously brought bits and pieces of all five references² together in the device of Rice. Applicant respectfully maintains that simply because each of the elements was known does not mean it would have been

² The mere fact that the rejection attempts to combine five references to meet the claimed subject matter suggests un-obviousness. While there is a general rule that it matters not how many references are strung together so long as they collectively make obvious the subject matter sought to be patented, there is another general rule that the greater the number of references strung together, the less likely it is that the invention was truly obvious. In the words of Circuit Judge Medina in *Ling-Temco-Vought, Inc. v. Kollsman Instrument Corporation* (2d Cir., 1967) 152 USPQ 446,51:

It is apparent that the more numerous the references..., the less likely it becomes that a person having ordinary skill in the art would have arrived at the result reached by the patent in suit. ...
[citations omitted].

In *Bela Seating Company, Inc. v. Poloron Products, Inc.*, 160 USPQ 646, 61, the Court concluded that the stringing together of a plurality of patents in an "attempt to invalidate plaintiff's claims tends in and of itself to negate the position of defendant that the patent in suit is invalid"

obvious to bring them together. In this regard, applicant respectfully relies on *Ex parte Levengood*, 28 USPQ 2d 1300, 1301 (BPAI 1993), where the Board stated as follows:

The examiner notes that each reference discloses a different aspect of the claimed process. The examiner also notes that all aspects were "well known in the art." The examiner then indicates that because the various aspects... were individually known in the art, the modifications [made to the primary reference were] "*well within the ordinary skill of the art at the time the claimed invention was made.*"

We reverse the rejection because the examiner has used the wrong standard of obviousness. [emphasis in original; bracketed material added]

The Board then continued to point out the necessity for the prior art to provide some evidence which would have led the person of ordinary skill in the art to the combination:

In order to establish a *prima facie* case of obviousness, it is necessary for the examiner to present **evidence** [footnote omitted], preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art **would have been led** to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. [citations omitted; italics in original; bracketed material added]

Yes, it is true that Corridon shows slider rings. But the prior art provides no suggestion, incentive or inference that,

in making a jewelry product fundamentally different from the primary reference relied upon, one skilled in the art **would have been led** to combine the bits and pieces from the additional four citations for incorporation into and modification of the Rice device for a substantially different purpose for which there is no teaching.

In short, applicant respectfully submits that the motivation for the proposed combination, required by MPEP 2143 and the case law (also see *In re Lee*, 61 USPQ 2d 1430, 1432-1433 (Fed. Cir. 2002)) was simply not there. Withdrawal of the rejection is in order and is respectfully requested.

Claim 28 has been rejected as obvious under §103 from Rice in view of Koven, Tully and Irons and further in view of Gilbertson USP 1,814,378. This five-reference combination rejection is also respectfully traversed.

Claim 28 depends from and incorporates the subject matter of claim 27, which in turn depends from and incorporates the subject matter of claim 26. Claim 27 has been rejected over a proposed combination of five references including Corridon, but claim 28 (which includes claim 27) does not rely on Corridon. Accordingly, applicant first respectfully notes that if claim 27 requires Corridon from the view of the PTO, then claim 28 should also require Corridon, thus providing a six-reference combination.

Regardless, Glibertson does not make up for the deficiencies of the proposed combination of Rice in view of Koven, Tully and Irons, or the proposed combination of the same references together with Corridon, as pointed out above, and has not been cited for that purpose. Consequently, claim 28 is patentable for the reasons already pointed out above.

Withdrawal of the rejection is in order and is respectfully requested.

Applicant has respectfully noted above that the newly presented claims 33-41 are patentable for the same reasons as claims 25-32. Applicant submits that these claims are further patentable because there is no suggestion anywhere among the references cited and relied upon to provide either a method for wearing a jewel as called for in claims 33-37 or a method for constructing an ornamental piece to be worn by an individual as called for in claims 38-41.

The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of applicant's claims.

Applicant believes that all issues raised in the Office Action have been addressed above in a manner favorable to allowance of the present application. Accordingly, applicant respectfully requests favorable reconsideration and early formal allowance.

Respectfully submitted,

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









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- | PAT. NO. | Title |
|------------------------------|---|
| 1 7,107,215 | Determining a compact model to transcribe the arabic language acoustically in a well defined basic phonetic study |
| 2 7,106,875 | Dual boundary pressure zone three dimensional microphone and hearing aid |
| 3 7,105,904 | CMOS type image sensor module having transparent polymeric encapsulation material |
| 4 7,105,642 | Monoclonal antibodies specific for phosphorylated estrogen receptor alpha (Ser118) and uses thereof |
| 5 7,105,637 | Dehydro-estriol (8-DHE3) and dehydro-pregnanetriol (7-DHPT), methods of their synthesis |
| 6 7,105,574 | Adjuvant compositions and methods for enhancing immune responses to polynucleotide-based vaccines |
| 7 7,105,535 | Oxazolyl-pyrazole derivatives as kinase inhibitors |
| 8 7,105,316 | Neisseria lactoferrin binding protein |
| 9 7,105,303 | Antibodies to hepatitis C virus asialoglycoproteins |
| 10 7,105,299 | Method for determining chum salmon haplotype using mitochondrial DNA |
| 11 7,105,182 | Periodontal regeneration composition and method of using same |
| 12 7,104,977 | Personal product emergency kit |
| 13 7,104,872 | Sandblasting cabinet |
| 14 7,104,799 | Mathematics teaching tool |
| 15 7,104,196 | Marker assembly, marking method, and kit |
| 16 7,104,163 | Tool kit |

- 17 [D527,674](#)  [Incense kit](#)
 - 18 [7,103,158](#)  [Dynamic interactive voice architecture](#)
 - 19 [7,102,011](#)  [Methods and compositions for the visualization of cellular organelles using tetrazolium salts](#)
 - 20 [7,102,005](#)  [Compositions and methods for detection and isolation of phosphorylated molecules](#)
 - 21 [7,101,999](#)  [Oxazine derivatives](#)
 - 22 [7,101,979](#)  [Antibodies to antiangiogenic compositions and methods](#)
 - 23 [7,101,976](#)  [EphA2 monoclonal antibodies and methods of making and using same](#)
 - 24 [7,101,968](#)  [One-step reduction and alkylation of proteins](#)
 - 25 [7,101,902](#)  [2-guanidinylimidazolidinedione compounds and methods of making and using thereof](#)
 - 26 [7,101,857](#)  [Crosslinkable biological material and medical uses](#)
 - 27 [7,101,842](#)  [Targeted delivery of drugs for the treatment of parasitic infections](#)
 - 28 [7,101,834](#)  [Process of treating a carpet with a composition comprising an absorbent gelling material](#)
 - 29 [7,101,685](#)  [Recombinant Sendai virus](#)
 - 30 [7,101,678](#)  [Method for detecting or quantifying basophils and eosinophils](#)
 - 31 [7,101,676](#)  [Methods for identifying compounds which inhibit binding of nucleocapsid 7 protein to HIV-1 RNA](#)
 - 32 [7,101,669](#)  [Enzyme-based regeneration of surface-attached nucleic acids](#)
 - 33 [7,101,554](#)  [Picornaviruses, vaccines and diagnostic kits](#)
 - 34 [7,101,549](#)  [Glycoprotein VI and uses thereof](#)
 - 35 [7,101,541](#)  [Utilization of non-viral sequences for minus-strand DNA transfer and gene reconstitution](#)
 - 36 [7,101,405](#)  [Oxidation dyeing composition for karatinous fibers comprising a cationic associative polyurethane](#)
 - 37 [7,101,249](#)  [Wiggle flyer](#)
 - 38 [7,101,179](#)  [Kit and method for taking a dental impression](#)
 - 39 [7,100,968](#)  [Toy vehicles having interchangeable body styles](#)
 - 40 [7,100,918](#)  [Board game kit and method of using](#)
 - 41 [7,100,881](#)  [Mount](#)
 - 42 [7,100,844](#)  [High impact waterjet nozzle](#)
 - 43 [7,100,771](#)  [Pain management kit for administration of medication](#)
 - 44 [7,100,582](#)  [Propane injection control system and apparatus for vehicles](#)
 - 45 [7,100,488](#)  [Structure and method for containing the detonation of an explosive](#)
 - 46 [D527,451](#)  [Combined ceiling fan motor housing and light kit](#)
 - 47 [7,098,340](#)  [Benzyl sulfonamide derivatives](#)
 - 48 [7,098,320](#)  [Nanoparticles having oligonucleotides attached thereto and uses therefor](#)
 - 49 [7,098,183](#)  [Nucleotide and amino acid sequences of oocyte factors for altering ovarian follicular growth in vivo or in vitro](#)
 - 50 [7,098,182](#)  [Nucleic acids and proteins from group B streptococcus](#)
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